

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES**

In re patent application of:) Attorney Docket No.: F-715
) Customer No.: 00919
Erik D.N. Monsen)
) Examiner: FU, Hao
Serial No.: 10/656,354) Group Art Unit: 4172
Filed: September 5, 2003)
Confirmation # 7816) Date: August 27, 2008

Title: PAYMENT RELEASE SYSTEM

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Commissioner for Patents
Alexandria, VA 22313-1450

APPELLANTS' BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 41.31 et seq. from the final rejection of claims 1-11 and 23-34 of the above-identified application mailed March 27, 2008. This Brief is in furtherance of the Notice of Appeal transmitted in this case on June 27, 2008. Accordingly, this brief is timely filed. The fee for submitting this Brief is \$510.00 (37 C.F.R. § 1.17(c)). Please charge Deposit Account No. **16-1885** in the amount of \$510.00 to cover these fees. The Commissioner is hereby authorized to charge any additional fees that may be required for this appeal or to make this brief timely or credit any overpayment to Deposit Account No. **16-1885**.

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no appeals or interferences known to Appellants, their legal representative, or the assignee that will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 1-11 and 23-34 are in the case and under final rejection of the Examiner.

Claims 12-22 are canceled.

Claims 1, 4-11, 23, and 26-34 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier ("Ferrier '437") in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto ("Morimoto '475").

Claims 2, 3, 24 and 25 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier ("Ferrier '437") in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto ("Morimoto '475") and in further view of U.S. Patent No. 7,080,044 to Cordery, et al. ("Cordery '044").

Appellants hereby appeal the final rejection of claims 1-11 and 23-34.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the Final Office Action of March 27, 2008. Therefore, the claims set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Claimed Subject Matter

Appellants' invention as presently claimed relates generally to new and useful systems and methods for authorizing payment to a seller upon delivery of an item to a buyer. The method includes registering each one of a plurality of receiving parties with a transaction module and registering each one of a plurality of sending parties with the transaction module. An identifier is generated and associated with a particular sending party and a particular item. Data is stored that relates the identifier and the particular sending party in the transaction module. The item is transported to a destination location specified by the receiving party where identifier data is retrieved. Next a correlation is made between the identifier data and a sending party. A debit is authorized from a selected receiving party's account. See Specification, ¶ 0011.

As shown in FIGs. 2A and 2B, reproduced below, a flow cart of an illustrative embodiment comprising representative processes according to the present application are described.

FIG. 2A

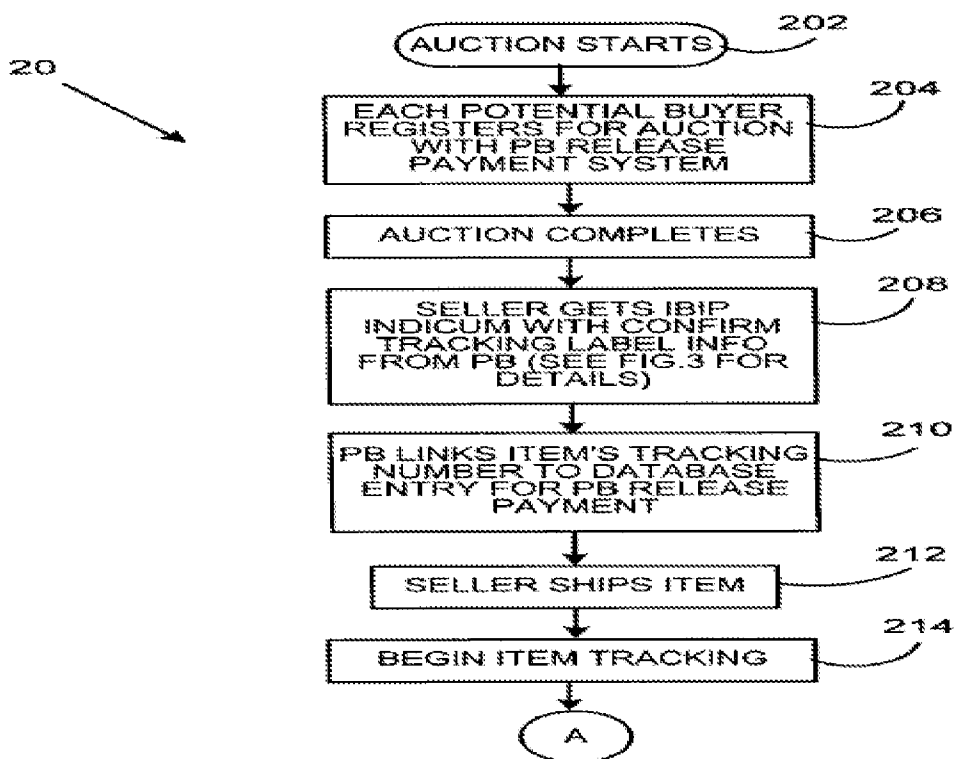
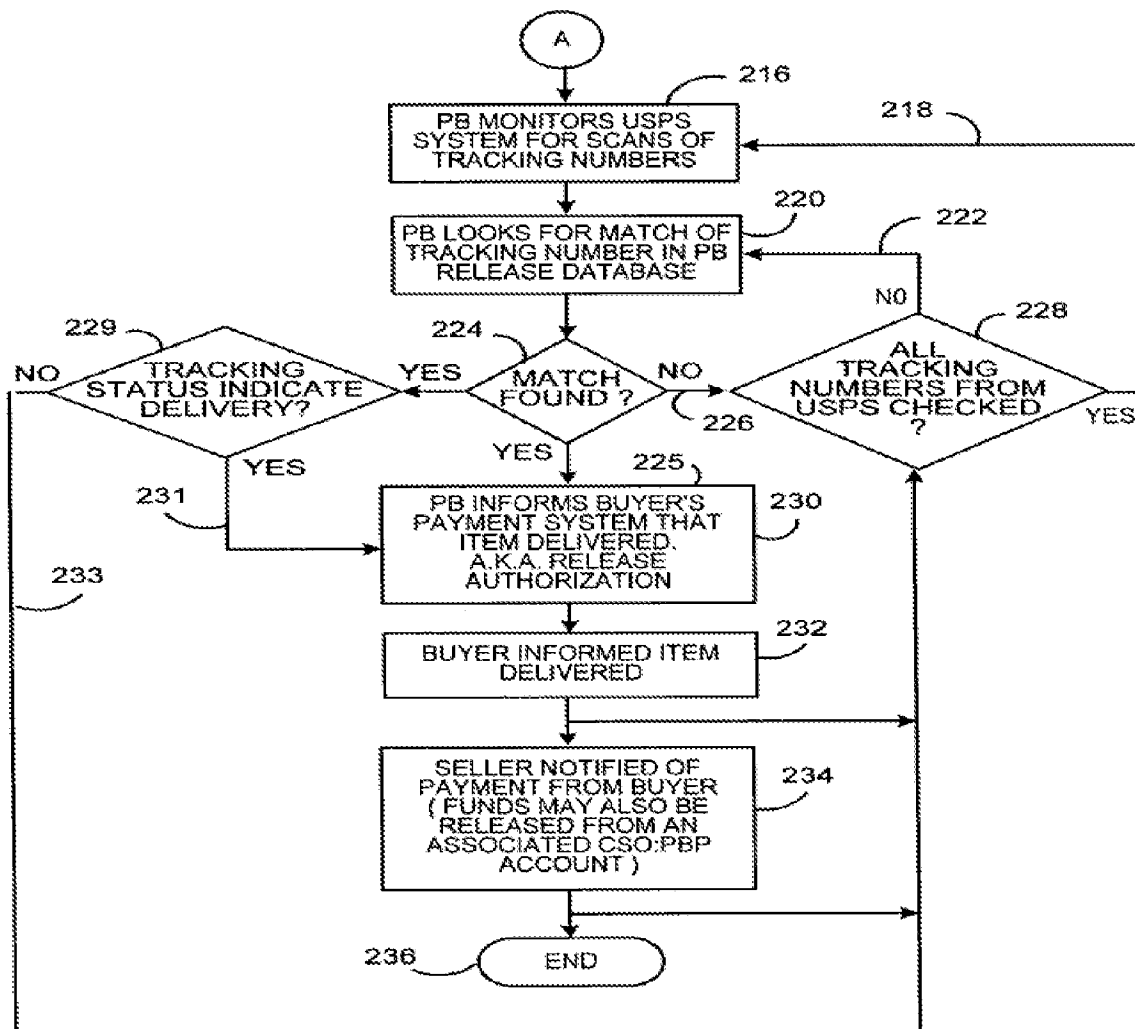


FIG. 2B



An illustrative electronic auction embodiment is described in which flow chart 20 is a series of steps implemented by a computer based system. The process starts in block 201 and as shown in block 202, the process is an auction to sell goods over the Internet. FIG. 2 shows an illustrative embodiment such that the sequence could be modified in alternatives, without departing from the scope of the invention. Block 204 shows that each potential buyer establishes a user account with a third party provider payment system. This payment release system could be implemented by a party such as the online auction company, a bank, Pitney Bowes, the seller company, the buyer

company or other third party. The registration may also entail the buyer and the seller providing either credit card information, checking account information, other bank account information or a billing address to a third party so that the third party can send invoices and verify that payment from the buyer has been received. Block 206 shows that the sale of the goods is completed. In the present example, the sale is in the context of an online auction in which one or more buyers bid on an item offered for sale by the seller. The online auction process may be implemented by a recognized Internet auction company such as e-Bay, or may be a sale between two companies, two individuals or a company and an individual, in which the seller offers an item for sale over the Internet or other network. Alternatively, the offer for sale may be through a newspaper advertisement or other means in which the seller and buyer do not meet "face-to-face" to conduct the transaction. See Spec. at ¶¶ 0046-49 and FIGs. 2A-2B.

Block 208 shows that the seller obtains an indicator, for example, an indicia, such as indicia that includes an IBIP (Information Based Indicia Program) indicia with tracking capability. This identifier that has tracking capability is typically either a portion of the indicia or an additional label. The indicator is typically generated by an open system postage meter or a closed system postage meter. Also, other tracking mechanisms may be used such as tracking numbers from the USPS (United States Postal Service) delivery confirmation, bar codes, encrypted indicators, indicators with watermarks or encoding. Block 210 shows that the third party, such as Pitney Bowes, bank or other trusted party links the item purchased by the buyer to the indicator. This step correlates the item and an indicator and is stored in memory. Block 212 shows that the seller ships the item. The shipping is typically done from a seller's (or shipper's) location or warehouse, or other location where the item is located. Upon shipment the item is typically packaged and the identifier is affixed to the outside of the package, parcel or mailpiece. See Spec. at ¶¶ 0050-52 and FIGs. 2A-2B.

Block 214 shows that once the item, package, parcel, or mailpiece (article) is shipped, it may be tracked using the identifier data and scanners at the various intermediate locations from the shipping location to the destination. Block 216 shows that the third party, such as Pitney Bowes or other third party responsible for releasing

payment upon delivery of the article to the destination address, can trace the article by monitoring the progress of the article.

Block 220 shows that the third party monitors the location of the article to determine when there is a match between the item being tracked and tracking data from the carrier, such as USPS. Decision block 224 determines when a match is found. If a match is found, line 225 leads to block 230 in which the third party informs the buyer's payment system that the article has been delivered and payment to the seller should be released. Also, in an alternate embodiment, "yes" line 227 leads to decision block 229 that determines whether the tracking status indicates delivery. If so, "yes" line 231 leads to block 230. If not, "no" line 233 leads to block 232. Block 232 shows that the buyer is informed that the article has been delivered and that payment has been authorized to be made to the seller. The buyer, or recipient, (a recipient may be a party who receives the item, but did not necessarily pay for it) may also contact the transaction module to confirm that the parcel or item is the correct item, and is not damaged, i.e., delivery is satisfactory. This feature has the advantage that a recipient may not receive the correct item or the item may have been damaged during shipping. Thus, the recipient may contact the transaction module, via telephone or e-mail, to indicate whether payment should be authorized. This feature also insures that the item has been delivered to the correct address. See Spec. at ¶¶ 0053-57 and FIGs. 2A-2B.

Line 226 from decision block 224 shows that when a match has not been found between the third party's tracking number, or identifier information and tracking information from the carrier, such as the USPS, decision block 228 is reached. Decision block 228 determines whether all tracking numbers have been checked, if not, line 222 leads to block 220. If all numbers have been checked, line 218 leads to block 216. Block 234 shows that the seller is notified that payment has been released from the buyer. Block 236 is an end block. See Spec. at ¶¶ 0058-59 and FIGs. 2A-2B.

Independent claim 1 is shown with illustrative annotated references to the specification, reference numerals and figures:

1. A method for authorizing payment upon delivery of an item to a destination comprising (20, FIGs. 2A, 2B; ¶¶ 0046-59):

- registering each one of a plurality of receiving parties with a transaction module (204);
- registering each one of a plurality of sending parties with the transaction module (204);
- generating an shipment tracking identifier for use with a shipping system (208);
- associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item (210);
- storing data relating to the identifier and the particular sending party in the transaction module (210);
- obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination (231);
- correlating the shipment tracking identifier data to the particular sending party and the item (230); and
- then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party (234).

Independent claim 23 is shown with illustrative annotated references to the specification, reference numerals and figures:

23. An apparatus for authorizing payment upon delivery of an item to a destination comprising (116, 228, 124, FIG. 1, ¶¶0028-45, 66-77):

- means for registering each one of a plurality of receiving parties with a transaction database (116, 228, 124, ¶¶0066-67);
- means for registering each one of a plurality of sending parties with the transaction database (116, 228, 124, ¶0068);
- means for generating an shipment tracking identifier for use with a shipping system (116, 228, 124, ¶0069);
- means for associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item (116, 228, 124, ¶0070);
- means for storing data relating to the identifier and the particular sending party in the transaction database (116, 228, 124, ¶0071);
- means for obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination (116, 228, 124, ¶0072);
- means for correlating the shipment tracking identifier data to the particular sending party and the item (116, 228, 124, ¶0074); and
- means for then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party (116, 228, 124, ¶0075).

Several dependent apparatus claims include “means for” limitations as shown below with illustrative recitations to associated disclosure in the specification that is not limiting, but merely provides an illustrative reference.

26. The apparatus as claimed in Claim 23, further comprising:
means for notifying the receiving party that the debit has occurred
(116, 228, 124, ¶0057).

27. The apparatus as claimed in Claim 23, further comprising:
means for notifying the sending party that the debit has occurred
(116, 228, 124, ¶0057).

31. The apparatus as claimed in Claim 23, further comprising
means for selecting a particular carrier from a plurality of carriers for
transporting the item (116, 228, 124, ¶0052).

32. The apparatus as claimed in Claim 23, further comprising:
means for tracking the item during the transportation of the item
from a first location to the destination location (116, 228, 124, ¶0055).

34. The apparatus as claimed in Claim 23, further comprising:
means for receiving confirmation information from the particular
receiving party outside of the shipping system confirming satisfactory
delivery prior to authorization (116, 228, 124, ¶0057).

The described means are not intended to be a complete list or limiting in any way, but merely illustrative.

Additional features of the invention are discussed below in the Argument section of this Brief. This summary is not intended to supplant the description of the claimed subject matter as provided in the claims as recited in Appendix A, as understood in light of the entire specification.

VI. Grounds of Rejection to Be Reviewed on Appeal

Whether claims 1, 4-11, 23, and 26-34 are patentable under 35 U.S.C. §103(a).

Whether claims 2, 3, 24 and 25 are patentable under 35 U.S.C. §103(a).

VII. Argument

As discussed in detail below, Appellants respectfully submit that the final rejection of claims 1-11 and 23-34 does not meet the threshold burden of presenting a prima facie case of unpatentability. Accordingly, Appellants are entitled to grant of those claims. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A Claims 1, 4-11, 23, and 26-34 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 1, 4-11, 23, and 26-34 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier (“Ferrier ‘437”) in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto (“Morimoto ‘475”).

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below.

In rejecting a claim under 35 U.S.C. §103, the Examiner is charged with the initial burden for providing a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 375 F.2d 385, 148 USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or combine applied references to arrive at the claimed invention. *In re Ochiai*, 37 USPQ2d 1127 (Fed. Cir. 1995); *In re Deuel*, 51 F.3d 1552, 34 USPQ 1210 (Fed. Cir. 1995); *In re Fritch*, 972 F.2d 1260, 23 USPQ 1780 (Fed. Cir. 1992); *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). See *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. ___, 127 S.Ct. 1727, 1735 (2007) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.* (quoting Kahn, 441 F.3d at 988)). *See also, Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1357 (Fed. Cir. 2007) (To avoid improper use of hindsight, the Examiner must articulate “a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does” in an obviousness determination. (quoting *KSR*, 127 S. Ct. at 1731)).

See also, In re Kahn, 441 F.3d 977 (Fed. Cir. 2006)(Most inventions arise from a combination of old elements and each element may often be found in the prior art. However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole).

Independent claim 1 recites:

1. A method for authorizing payment upon delivery of an item to a destination comprising:
 registering each one of a plurality of receiving parties with a transaction module;
 registering each one of a plurality of sending parties with the transaction module;
 generating an shipment tracking identifier for use with a shipping system;
 associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item;
 storing data relating to the identifier and the particular sending party in the transaction module;
 obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination;
 correlating the shipment tracking identifier data to the particular sending party and the item; and
 then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party.

(emphasis added).

Independent claim 23 recites:

23. An apparatus for authorizing payment upon delivery of an item to a destination comprising:
 means for registering each one of a plurality of receiving parties with a transaction database;
 means for registering each one of a plurality of sending parties with the transaction database;
 means for generating an shipment tracking identifier for use with a shipping system;
 means for associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item;
 means for storing data relating to the identifier and the particular sending party in the transaction database;
 means for obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination;
 means for correlating the shipment tracking identifier data to the particular sending party and the item; and
 means for then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party.

(emphasis added).

In the Final Office Action, the Examiner rejects the amended claims using the previously applied references and in a Response to Argument section on page 2, suggests the shipping tracking identifier is generated by the USPS or shipping carrier. Contrary to the Examiner's assertion, the specification at publication ¶0050 clearly teaches that an open system postage meter such as that operated by the trusted third party generates the described indicator. Appellants also dispute any new implied statement of Official Notice that might have been intended.

Moreover, the Examiner suggests that Ferrier '437 "implies" an identifier has shipment tracking ability. Appellants respectfully disagree. The reference does not teach or suggest generating a shipment tracking identifier in paragraphs 0071 or 0075, but rather only determines which courier was selected – not tracking the item through the courier system. Here, each independent claim recites generating a shipment tracking identifier that none of the cited references teach or suggest with regard to the claimed invention as a whole. Similarly, Ferrier '437 does not teach or fairly suggest

associating a shipment tracking identifier with a sending party, receiving party and an item, since it does not create such an identifier.

Furthermore, it appears rather that Ferrier '437 teaches away from a shipment tracking identifier since the identifier taught there is not globally unique in a carrier system and therefore could not be used as a shipment tracking identifier.

As apparently acknowledged by the Examiner on page 4, sixth paragraph of the Final Office Action, and as in the prior COD system, Ferrier '437 in paragraph 0064 describes only having the courier collect payment from the recipient as a condition precedent of delivery if the recipient happens to be home when the item is delivered.

The Examiner incorrectly suggests that prior COD systems such as the USPS COD system render the invention as presently claimed obvious. In those systems, recipient payment was a condition precedent to delivery. The recipient had to be present and the recipient had to pay – both significant deficiencies in the art. Here, Appellants have disclosed a system that has delivery as the condition precedent to payment release. The recipient need not be present and the recipient need not be the payor. Accordingly, the system disclosed by Appellants includes several advantages over the prior art including but not limited to those described here. Similarly, as the Examiner apparently acknowledges at top of page 3 of the Final Office Action, Ferrier '437 does not teach or suggest anything further than the traditional COD system in paragraph 0064.

Moreover, the Morimoto '475 reference is not properly combined since it has nothing to do with payment systems. It is important to note that one of skill in the art would not look to Morimoto '475 to modify Ferrier '437 or any other traditional COD system since it was not necessary to track the item at all. In the COD systems, the recipient had to be home and have payment before the courier would leave the package. Accordingly, there would be no need to track the item. The Examiner is improperly using hindsight to use the teachings of the present invention as a roadmap to suggest a system that tracks a shipping identifier to determine delivery. Here, the prior art did not teach such a system that does not require the recipient to be present or pay – rather the present application did.

Dependent claims 4-11 and 26-34 are patentable over the cited reference for at least the reasons described above with reference to the associated independent claim and any intervening claims.

Moreover, with regard to claims 6-8 and 28-20, Appellants are claiming three different configurations of the described system, respectively operated by receiving party, sending party and third party. Ferrier '437 does not teach or suggest all three such systems and the Examiner's interpretation of the term operated is clearly incorrect as allegedly equivalent to using.

Moreover, the cited references, even if properly combined, do not teach or suggest every limitation of claims 1, 4-11, 23, and 26-34.

Accordingly, Appellant respectfully submits that the rejection is clearly in error and should be reversed.

B Claims 2, 3, 24 and 25 are not Unpatentable under 35 U.S.C. § 103(a)

Claims 2, 3, 24 and 25 are in the case and stand finally rejected under 35 U.S.C. 103(a) as allegedly rendered obvious by U.S. Patent Application Publication No. 2005/0177437A1 by Ferrier ("Ferrier '437") in view of U.S. Patent Application Publication No. 2002/0120475A1 by Morimoto ("Morimoto '475") and in further view of U.S. Patent No. 7,080,044 to Cordery, et al. ("Cordery '044").

Appellants respectfully disagree with the rejection and urge its reversal for at least the reasons stated below. Initially, dependent claims 2, 3, 24 and 25 are patentable over the cited references for at least the reasons described above with reference to the associated independent claim and any intervening claims.

Moreover, if the references when combined suggest an inoperative device, the Examiner may not use the references to establish a prima facie rejection. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339 (Fed. Cir. 2001)(if references taken in combination would produce a "seemingly inoperative device," then such references teach away from the combination and cannot serve as predicates for a prima facie case of obviousness).

As described above, the system of Ferrier '437 uses an identifier that is not globally unique for a carrier and thus would not be used with a shipment tracking identifier. As such, the proposed combination is improper as it would apparently not function.

Moreover, the cited references, even if properly combined, do not teach or suggest every limitation of claims 2, 3, 24 and 25.

Accordingly, Appellant respectfully submits that the rejection is clearly in error and should be reversed.

IX. Conclusion

In Conclusion, Appellants respectfully submit that the final rejection of claims 1-11 and 23-34 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,

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VIII – CLAIMS APPENDIX
APPENDIX A

1. A method for authorizing payment upon delivery of an item to a destination comprising:

registering each one of a plurality of receiving parties with a transaction module;
registering each one of a plurality of sending parties with the transaction module;
generating an shipment tracking identifier for use with a shipping system;
associating the shipment tracking identifier with a particular sending party, a particular receiving party and the item;

storing data relating to the identifier and the particular sending party in the transaction module;

obtaining shipment tracking identifier data at a destination location from the shipping system indicating that the item has arrived at the destination;

correlating the shipment tracking identifier data to the particular sending party and the item; and

then authorizing a debit associated with the item from a selected account associated with the particular receiving party to a selected account of the particular sending party.

2. The method as claimed in Claim 1, wherein the shipment tracking identifier is a postage indicium generated from a closed system postage meter.

3. The method as claimed in Claim 1, wherein the shipment tracking identifier is a postage indicium generated from an open system postage meter.

4. The method as claimed in Claim 1, further comprising:
notifying the receiving party that the debit has occurred.

5. The method as claimed in Claim 1, further comprising:
notifying the sending party that the debit has occurred.

6. The method as claimed in Claim 1, wherein the transaction module is operated by the receiving party.

7. The method as claimed in Claim 1, wherein the transaction module is operated by the sending party.

8. The method as claimed in Claim 1, wherein the transaction module is operated by a third party.

9. The method as claimed in Claim 1, further comprising selecting a particular carrier from a plurality of carriers for transporting the item.

10. The method as claimed in Claim 1, further comprising:
receiving confirmation information from the particular receiving party outside of the shipping system, at the transaction module, confirming satisfactory delivery, prior to the authorization step.

11. The method as claimed in Claim 1, wherein the identifier is stored as a bar code representation and the obtaining step includes scanning the bar code.

23. An apparatus for authorizing payment upon delivery of an item to a destination comprising:
means for registering each one of a plurality of receiving parties with a transaction database;
means for registering each one of a plurality of sending parties with the transaction database;
means for generating an shipment tracking identifier for use with a shipping system;
means for associating the shipment tracking identifier with a particular

sending party, a particular receiving party and the item;
means for storing data relating to the identifier and the particular
sending party in the transaction database;
means for obtaining shipment tracking identifier data at a destination
location from the shipping system indicating that the item has arrived at the destination;
means for correlating the shipment tracking identifier data to the particular
sending party and the item; and
means for then authorizing a debit associated with the item from a
selected account associated with the particular receiving party to a selected account of
the particular sending party.

24. The apparatus as claimed in Claim 23, wherein the shipment tracking
identifier is a postage indicium generated from a closed system postage meter.

25. The apparatus as claimed in Claim 23, wherein the shipment tracking
identifier is a postage indicium generated from an open system postage meter.

26. The apparatus as claimed in Claim 23, further comprising:
means for notifying the receiving party that the debit has occurred.

27. The apparatus as claimed in Claim 23, further comprising:
means for notifying the sending party that the debit has occurred.

28. The apparatus as claimed in Claim 23, wherein the transaction database is
operated by the receiving party.

29. The apparatus as claimed in Claim 23, wherein the transaction database
is operated by the sending party.

30. The apparatus as claimed in Claim 23, wherein the transaction database is operated by a third party.

31. The apparatus as claimed in Claim 23, further comprising means for selecting a particular carrier from a plurality of carriers for transporting the item.

32. The apparatus as claimed in Claim 23, further comprising:
means for tracking the item during the transportation of the item from a first location to the destination location.

33. The apparatus as claimed in Claim 23, wherein the identifier is stored as a bar code representation and the means for the obtaining step is a scanner device.

34. The apparatus as claimed in Claim 23, further comprising:
means for receiving confirmation information from the particular receiving party outside of the shipping system confirming satisfactory delivery prior to authorization.

Appendix IX – Evidence Appendix

None

Appendix X – Related Proceedings Appendix

None